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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,036	01/20/2004	William L. Dunbar JR.	DEP 5033NP	1189
27777	7590	04/22/2009		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER HOFFMAN, MARY C	
			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			04/22/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/761,036

**Applicant(s)**

DUNBAR ET AL.

**Examiner**

MARY HOFFMAN

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4, 7, 9, 11 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 7, 9 and 11 is/are rejected.
- 7) ☒ Claim(s) 15-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/20/2004, 8/16/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Allowable Subject Matter***

The indicated allowability of claims 4, 7, 9, 11 and 18-20 is withdrawn in view of the newly discovered reference(s) to Stull (U.S. Pat. No. 2,625,967) and Howard (U.S. Pat. No. 2,370,407). Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Stull (U.S. Pat. No. 2,625,967).

Stull discloses a tool for seating a spinal rod in a rod-receiving portion of a spinal implant, the tool comprising: a body (58) having a proximal end portion and a distal end portion, the distal end portion including a first and second flexible branch for gripping a spinal implant, the flexible branches being biased to a closed position; an inserter shaft (50) slidably received within the body, the inserter shaft having a distal end adapted to hold a closure mechanism for the implant; a threaded collar (68), adapted to couple the body and the inserter shaft, wherein the inserter shaft forces a spinal rod into the rod-receiving portion of the implant; and a substantially cylindrical outer sleeve (96 and/or

98) disposed about the distal end portion of the body and movable between a first position and a second position in which the outer sleeve surrounds the branches to inhibit separation of the first and second flexible branches.

Stull further discloses a tool for seating a spinal rod in a rod-receiving portion of a spinal implant, the tool comprising: a body (58) having a proximal and distal end portion, wherein an interior channel extends between the distal and proximal portions, the distal end portion having flexible branches for gripping a spinal implant and the proximal end portion having external threads; an inserter shaft (50) slidable within the interior channel of the body having a proximal end portion, a distal end portion, and a transition zone (36) located between the distal and proximal end portions, the transition zone having a diameter larger than the proximal end portion, the distal end portion adapted to hold a closure mechanism for the spinal implant; and a collar (30/68) having an internally threaded hollow body (threaded region at 30) and a central shaft (at 68) attached to the hollow body, wherein the central shaft limits independent motion between the inserter shaft and the collar, wherein the diameter of the transition zone of the inserter shaft is greater than an inner diameter of the central shaft of the collar, the central shaft of the collar having a distal and a proximal portion, the proximal portion attached to the hollow body and the distal portion extending past the hollow body and having an abutment surface (at 34) for engaging the transition zone portion of the inserter shaft. The gripping branches are biased in a closed position.

Claims 11 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Howard (U.S. Pat. No. 2,370,407).

Howard discloses a tool for seating a spinal rod in a rod-receiving portion of a spinal implant comprising: a body (17) having a proximal and a distal end portion, the distal end portion having branches (19) for gripping a spinal implant, wherein an interior channel extends between the distal and proximal ends; an inserter shaft (14) having a proximal and a distal end portion, the distal end portion (15) adapted to hold a closure mechanism for the spinal implant, wherein the shaft is sized to fit within the interior channel of the body; a guide mechanism co-operable with the shaft and the body whereby the guide mechanism limits an independent movement of the shaft within the body, the guide mechanism including a channel (18) and a pin (22) adapted to fit within the channel, the channel located on the body and extending parallel to a longitudinal axis of the body, the pin located on the shaft; and a substantially cylindrical outer sleeve (23) disposed about the distal end portion of the body and movable between a first position and a second position in which the outer sleeve surrounds the branches to inhibit separation of the branches. The pin and channel prevent the shaft from being removed from the body. The independent movement limited is a rotational orientation of the inserter shaft with respect to the body. The independent movement limited is an axial translation of the inserter shaft with respect to the body.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARY HOFFMAN whose telephone number is (571)272-5566. The examiner can normally be reached on Monday-Thursday 10:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary C. Hoffman/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733